

Docket No. YOR920030013US1
YOR.427

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

David Abraham et al.

Serial No.: 10/680,260

Group Art Unit: 2814

Filed: October 8, 2003

Examiner: Mai, Anh D.

For: METHOD AND SYSTEM FOR PATTERNING OF MAGNETIC THIN FILMS
USING CHEMICAL TRANSFORMATION

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

PETITION TO WITHDRAW OBJECTION TO CLAIMS UNDER 37 C.F.R.
§1.181

Sir:

Applicants Petition for the reconsideration and withdrawal of the objection to claim

13. Claim 13 currently stands objected to under 37 C.F.R. §1.75(c), as allegedly being of improper independent form for allegedly failing to further limit the subject matter of a previous claim. The Examiner, however, is clearly incorrect.

That is, claim 1 clearly recites “a method of patterning a magnetic thin film”. Claim 13 further limits the subject matter of claim 1 by claiming the additional step of producing a magnetic device after the limitation of “transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical formation”. A person reasonably skilled in the art would clearly understand what is meant by the phrase “producing a magnetic device” and that “producing a magnetic device” is clearly different from “transforming a portion of the magnetic thin film to be non-magnetic and electrically insulating using a chemical formation”. Therefore, claim 13 clearly further limits the subject matter of claim 1

and therefore is clearly in proper dependent form.

The Examiner erroneously alleges that “Applicant still fails to distinguish the magnetic film formed by claim 1 and the so called magnetic “device” of claim 13” (see Office Action dated January 3, 2007 at page 2). The Examiner, however, is clearly incorrect.

That is, Applicants have repeatedly pointed out that claim 1 does not recite “producing a magnetic device”. Indeed, claim 1 clearly recites “a method of patterning a magnetic thin film”. Claim 1 does not produce a magnetic device. Claim 13, however, recites the additional method step of forming a magnetic device.

Applicants submit that the Specification and Drawings of the Application clearly point out the difference between a magnetic thin film and a magnetic device, as recited in the claims.

Specifically, the Application describes in detail the process of transforming a portion of the magnetic thin film using a reactive plasma (e.g., see Application at page 7, line 3 through page 8, line 14). The Application further describes, in detail, that “[s]ubsequent processing can proceed in a known manner (e.g., as typically performed) to produce a functioning magnetic device. An example of such a structure is shown in Figures 2A-2C” (e.g., see Application at page 8, lines 21-23).

Figures 2A-2C, and the corresponding description in the Specification at page 9, line 1 through page 10, line 5, illustrates, in detail, a structure (magnetic device) (e.g., 200; Applicants submit that reference numbers are merely provided for the convenience of the Examiner and are not meant to limit the scope of the claimed invention in any manner) having a substrate (e.g., 210) having a magnetic thin film.

Furthermore, Figure 3, and the corresponding description in the Specification at page 10, lines 6-18, illustrates a flowchart of a method that corresponds to the processing steps shown in Figures 2A-2C. Specifically, the exemplary method illustrated in Figure 3 includes forming a magnetic thin film on a substrate (e.g., 310), exposing the thin film to a reactive plasma (e.g., 330) and then forming a functioning magnetic device (e.g., 340).

Thus, one of ordinary skill in the art, in view of the detailed description in both the Specification and the Drawings of the Application, would clearly understand the difference between the magnetic thin film of claim 1 and the magnetic device of claim 13.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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